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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,616	04/07/2005	Patrice Bujard	4-22763/A/PCT	7004
324 7590 02/07/2007 CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			EXAMINER FLETCHER III, WILLIAM P	
			ART UNIT 1762	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/07/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/530,616

Applicant(s)

BUJARD ET AL.

Examiner

William P. Fletcher III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This application is a 371 of PCT/EP03/11188, filed October 9, 2003, and published as WO 2004/035911 A3.

***Response to Amendment***

2. The compliant amendment and response, filed November 16, 2006, is noted.
3. Claims 1-20 remain pending in this application.

***Response to Arguments***

4. Applicant's arguments, see the remarks, filed November 16, 2006, with respect to the objections and rejections set-forth in the prior Office action, have been fully considered and are persuasive.

A. The objection to the abstract, specification, and claims, as well as the rejections set-forth in paragraphs 11A, C, D, and F, of the prior Office action, are withdrawn in light of Applicant's amendment.

B. The rejection set-forth in paragraph 11B of the prior Office action is withdrawn. Applicant's arguments have persuaded the Examiner that the term is sufficiently definite.

C. The rejection set-forth in paragraph 11E of the prior Office action is withdrawn. The Examiner thanks Applicant for clarifying the antecedent basis of the terms in claims 7 and 9.

5. Upon further consideration, new grounds of objection and rejection are set-forth below.

***Claim Objections***

6. Claim 1 is objected to because of the following informalities:

A. The phrase "at least one coating consists essentially of" is grammatically incorrect and should read "at least one coating consist[[s]]ing essentially of." Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

***Claim Rejections - 35 USC § 112***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 1 provides for the use of gloss pigments in a process for dyeing or printing textile fiber materials, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

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10. Claims 7, 8, 9, 14, 15, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claim 7 recites applying a layer having a thickness of from 0 to 500 nm, which is contradictory since the claim requires applying the layer, but recites a thickness of 0 nm which is no layer at all. Claims 8 and 9 are similarly indefinite for reciting thicknesses of 0 to 300 nm. Claim 17 is similarly rejected because this claim depends from claim 9, but fails to remedy this contradiction.

B. Claims 8 and 9 are indefinite because neither the claim nor the specification defines  $n$ ,  $k$ , or  $i$ . Claims 14, 15, and 17 are similarly rejected because these claims depend from claims 8 or 9, but fail to remedy this indefiniteness.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 1-3 and 6-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bujard et al. (US 5,766,335 A) in view of Pelzig (US 4,956,404 A).

A. With respect to claim 1:

i. Bujard teaches various processes for coating substrates with paints or printing inks containing a pigment comprising a core of substantially transparent or metallic reflecting material and at least one coating consisting essentially of one or more silicon dioxides having an average O:Si molar ratio of 0.25 to 0.95 [2:62-3:2]. This satisfies Applicant's claimed pigment A.

ii. Insofar as Bujard teaches that the above structure may be further coated [see Example 25, for instance], this satisfies Applicant's claimed pigment B having a core consisting essentially of one or more silicon dioxides having an average O:Si molar ratio of 0.03 to 0.95.

iii. While Bujard does not place any particular limitation on the types of substrates that may be coated, the reference does not explicitly teach a textile fiber material. Pelzig teaches the printing of textile fiber materials with inks containing lustrous pigments of coated mica [2:36-37 and 5:13-25]. Consequently, it would have been obvious to one of ordinary skill in the art to modify the process of Bujard to as to utilize, as the substrate, a textile fiber substrate, as suggested by Pelzig. One of ordinary skill in the art would have been motivated to do so by the desire and

expectation of successfully applying the composition thereto, based on the teaching of Pelzig that it is known in the art to do so.

B. With respect to claims 2, 3, and 12, Bujard teaches that the core may be any of the materials recited in these claims [3:31-44].

C. With respect to claims 6 and 13-15, Example 35 teaches the following structure:  $\text{SiO}_2/\text{SiO}_{0.41}/\text{Al}/\text{SiO}_{0.41}/\text{SiO}_2$ . If the  $\text{SiO}_2/\text{SiO}_{0.41}$  portion is taken as the "core," then the core thickness taught by this example is 200 nm.

D. With respect to claim 7, referring again to Example 35, the outer  $\text{SiO}_{0.41}/\text{SiO}_2$  structure, with a thickness of 200 nm, satisfies the limitations of this claim.

E. With respect to claims 8 and 9, Example 35 teaches that the coating may additionally contain a 50 nm layer metallic aluminum. It is the Examiner's position that the transparency, refractive, and reflective properties of this layer are all result-effective variables effecting the final appearance of the printed composition and are well-within the purview of one of ordinary skill in the art to control and adjust so as to optimize the appearance by routine experimentation, absent evidence of unexpected results demonstrating the criticality of the claimed parameters [MPEP 2144.05].

F. With respect to claims 10, 16, 17, and 18, as noted above, the combination of Bujard and Pelzig teaches printing of the textile fiber material.

G. With respect to claims 11, 19, and 20, it is the Examiner's position that transfer printing and thermoprinting are expedients well-known in the art.

***Allowable Subject Matter***

14. While all of the claims have been rejected above, the Examiner notes that a portion of the claimed subject matter appears allowable over the prior art. Specifically, the layer structures taught in claims 4 and 5. While control of the deposition parameters determining the composition of the layers is known and described in Bujard, this reference also describes the coating as "an intimate and substantially amorphous mixture of compounds with silicon in different states of oxidation, but the exact structure is not known" [3:53-55, emphasis added]. Consequently, while it is within the level of skill of one of ordinary skill in the art to deposit a coating of this structure, there is no motivation in the prior art to do so.

***Conclusion***

15. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571)

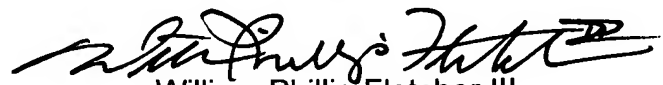


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272-1419. The examiner can normally be reached on Monday through Friday, 0900h-1700h.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William Phillip Fletcher III  
Primary Examiner  
Art Unit 1762

February 4, 2006